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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/723,408

Filing Date: November 25, 2003

Appellant(s): SNOWDEN ET AL.

James Bagarazzi
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/30/2008 appealing from the Office actions mailed 6/18/2008 (Advisory Action), 5/22/2008 (Advisory Action), and 2/12/2008 (Final Rejection).

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6a) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct, except only claims 39 and 40 are rejected under 35 USC 103(a) over Potts in view of Simpson in view of Gilbert or Weipert, and further in view of Evers. The applicant correctly lists said ground of rejection under the ARGUMENT section.

(6b) Grounds of Rejection Not to be Reviewed on Appeal

The examiner withdraws Weipert as a secondary reference. Therefore, the claims are currently rejected as follows:

- 1) Claims 23, 25, 28-31 and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,145,727 to Potts in view of USPN 5,023,130 to Simpson in view of USPN 4,000,233 to Gilbert.
- 2) Claims 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,145,727 to Potts in view of USPN 5,023,130 to Simpson in view of USPN 4,000,233 to Gilbert as applied to claims 23, 25, 28-31 and 34-37 above, and further in view of USPN 5,296,282 to Evers.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|-----------|---------|---------|
| 5,145,727 | POTTS | 9-1992 |
| 5,023,130 | SIMPSON | 6-1991 |
| 4,000,233 | GILBERT | 12-1976 |
| 5,296,282 | EVERS | 3-1994 |

(9) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 23, 25, 28-31 and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,145,727 to Potts in view of USPN 5,023,130 to Simpson in view of USPN 4,000,233 to Gilbert.

Potts discloses a topically treated (treated on the surface of the fibers) nonwoven fabric laminate comprising a repellent agent (see entire document including column 17, line 62 through column 18, line 5). Potts discloses that the nonwoven fabric may be a spunbond and meltblown fabric laminate (column 17, line 62 through column 18, line 5). Potts specifically discloses that

“at least one melt-extruded nonwoven layer” of a two layer nonwoven fabric laminate is prepared in the disclosed manner resulting in the agent on the surface of the fibers (column 6, lines 6-33). Therefore, Potts discloses that all layers of the laminate may be prepared as disclosed. In the event that it is shown that Potts does not disclose the claimed embodiment with sufficient specificity, it would have been obvious to one having ordinary skill in the art at the time the invention was made to prepare all the layers with the repellent agent, because some applications require a laminate with repellent characteristics throughout the laminate.

Potts discloses that the repellent may be any of a variety of fluoropolymers (column 13, lines 27 through column 14, line 37), but Potts does not specifically disclose whether any of the fluoropolymers are non-ionic. Simpson discloses that ZEPEL 7040 is a non-ionic fluoropolymer repellent additive that is known in the repellent nonwoven fabric art (see entire document including column 10, lines 55-64). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the repellent additive from any suitable repellent material, such as a non-ionic fluoropolymer, such as ZEPEL 7040, as taught by Simpson, because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability and desired characteristics.

Potts does not appear to disclose the method disclosed in the current specification (applying the composition in an aqueous solution and then drying to remove the water), but Potts does disclose that the composition ends up on the surface of the fibers (without the presence of water), by migration upon formation, and that the fabric is then subjected to heat (column 6, lines 6-40). Potts specifically discloses that the additive completely covers the surface of the fiber as the segregation proceeds to completion (column 10, lines 20-32). Absent a showing to the

contrary, it is the examiner's position that the article of the applied prior art is identical to or only slightly different than the claimed article. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983). The applied prior art either anticipated or strongly suggested the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with the applied prior art.

Potts discloses that an antistatic agent may be present on the fibers (column 10, lines 33-47), but Potts does not specifically mention the use of an organic phosphate ester antistatic agent. Gilbert discloses that it is known in the antistatic art to use an organic phosphate ester antistatic agent (see entire document including column 2, lines 12-38). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the antistatic agent from any suitable antistatic composition, such as an organic phosphate ester, as taught by Gilbert, because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability and desired characteristics.

Potts does not appear to mention applying the antistatic agent over the fluoropolymer coating, but Gilbert specifically discloses that there are advantages to externally applied antistatic agents (coatings) compared to internally applied agents (added to the base material). Gilbert discloses that internally applied agents do not produce an immediate effect but rather require as much as three days or more to migrate to the surface (column 1, lines 6-20). In addition, Gilbert discloses that internally applied antistatic agents cause color problems (column 1, lines 6-20). Further, Gilbert discloses that if the antistatic agent is internally applied there is a problem of static buildup (column 1, lines 41-46). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to externally apply the antistatic agent to the laminate, rather than apply an internal antistatic agent, motivated by a desire to provide the laminate with an immediate antistatic effect and/or to avoid color problems and/or to avoid static buildup.

Regarding claim 25, Potts discloses that the nonwoven fabric may be a medical fabric (column 17, lines 47-61).

Regarding claims 28-31 and 34-36, Potts does not disclose the specific hydrostatic head value or alcohol repellency of the treated nonwoven fabric, but considering that the fabric taught by the applied prior art is identical to the claimed treated nonwoven fabric (spunbond/meltblown/spunbond laminate coated on one surface with an antistatic agent and the other surface with a non-ionic fluoropolymer repellent), it appears that the fabric inherently possesses the claimed properties.

The Patent and Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and

prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431 (CCPA 1977).

3. Claims 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,145,727 to Potts in view of USPN 5,023,130 to Simpson in view of USPN 4,000,233 to Gilbert as applied to claims 23, 25, 28-31 and 34-37 above, and further in view of (to show inherency) USPN 5,296,282 to Evers.

Simpson discloses that ZEPEL 7040 is a known non-ionic fluoropolymer repellant, but Simpson does not appear to disclose the specific composition of ZEPEL 7040. Evers discloses that ZEPEL 7040 is a well-known perfluoroalkylethylacrylate repellent material (see entire document including column 3, lines 50-68).

(10) Response to Argument

Claims 23, 25, 28-31 and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Potts in view of Simpson in view of Gilbert.

The applicant asserts that Gilbert and Potts disclose nonanalogous art because the coated, melt extruded thermoplastic polymer of Gilbert is in a larger, hollow tube form while the coated, melt extruded thermoplastic polymer of Potts is in smaller, solid fiber form. The examiner respectfully disagrees. Gilbert and Potts both relate to coating melt extruded thermoplastic polymer. More specifically, both Gilbert and Potts relate to coating melt extruded thermoplastic polymer with an antistatic agent. Even more specifically, both Gilbert and Potts relate to coating melt extruded thermoplastic polymer with an internal antistatic agent.

The applicant asserts that the concerns of Gilbert do not relate to the material of Potts. The examiner respectfully disagrees. Gilbert discloses that internally applied agents, applied to melt extruded thermoplastic polymer material, do not produce an immediate effect but rather require as much as three days or more to migrate to the surface (column 1, lines 6-20). In addition, Gilbert discloses that internally applied antistatic agents, applied to melt extruded thermoplastic polymer material, cause color problems (column 1, lines 6-20 and lines 41-46). Further, Gilbert discloses that internally applied antistatic agents, applied to melt extruded thermoplastic polymer material, cause static buildup problems (column 1, lines 41-46). Considering that Potts relates to internally applied antistatic agents to melt extruded thermoplastic polymer, it is clear that the concerns of Gilbert relate to the material of Potts.

The applicant asserts that there is no motivation to externally apply an antistatic agent to the fibers of Potts because Potts discloses that the internally applied agent begins migrating the moment the fibers are formed (column 18, lines 14-27). The examiner respectfully disagrees. Firstly, Potts does not teach or suggest that all of the additive migrates to the surface upon fiber formation. Rather, Potts teaches that the migration merely begins upon fiber formation (column 18, lines 14-27). Gilbert also teaches that these agents generally require three days or more to migrate to the surface (column 1, lines 6-20). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to externally apply the antistatic agent to the laminate, rather than apply an internal antistatic agent, motivated by a desire to provide the laminate with an immediate complete antistatic effect. Secondly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to externally apply the antistatic agent to the laminate, rather than apply an internal antistatic agent, motivated by a desire to avoid color problems (see column 1, lines 6-20 and lines 41-46 of Gilbert). Thirdly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to externally apply the antistatic agent to the laminate, rather than apply an internal antistatic agent, motivated by a desire to avoid static buildup (see column 1, lines 41-46 of Gilbert). Fourthly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to externally apply the antistatic agent to the laminate, rather than apply an internal antistatic agent, because it is within the general skill of a worker in the art to select a known method on the basis of its suitability and desired characteristics.

The substitution of known equivalent structures involves only ordinary skill in the art. *In re Fout* 213 USPQ 532 (CCPA 1982); *In re Susi* 169 USPQ 423 (CCPA 1971); *In re Siebentritt* 152 USPQ 618 (CCPA 1967); *In re Ruff* 118 USPQ 343 (CCPA 1958). When a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result. **KSR**

v. Teleflex.

Regarding the color problems associated with antistatic agents in melt extruded thermoplastic polymer compositions, as disclosed by Gilbert (column 1, lines 6-20 and lines 41-46), the applicant asserts that said color problems are not applicable to micron-sized fibers simply because Potts does not mention said color problems. The examiner respectfully disagrees. The mere absence of a positive recitation of a problem is not basis for an assumption of the exclusion of a problem. The applicant has failed to show that the melt extruded thermoplastic polymer color problems disclosed by Gilbert do not relate to the melt extruded thermoplastic polymer compositions of Potts.

The applicant asserts that there is no motivation to externally apply the antistatic agent to the fibers of Potts because Potts prefers to exclude external treatment of the fibers (paragraph bridging columns 5 and 6). The examiner respectfully disagrees. The problem motivating the patentee may be only one of many addressed by the patent's subject matter. The question is not whether the combination was obvious to the patentee (Potts) but whether the combination was obvious to a person with ordinary skill in the art. Under the correct analysis, any need or problem known in the field of endeavor at the time of invention can provide a reason for combining the elements in the manner claimed. **KSR v. Teleflex.**

Claims 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Potts in view of Simpson in view of Gilbert, and further in view of Evers.

The applicant fails to separately argue the claims.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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